

## **REMARKS**

Claims 1-7, 11, 12, 14-17, 19-27, 29-38, and 41-44 were pending and were rejected. Claims 8-10, 13, 18, 28, 39, and 40 were pending and were objected to. Claims 1-44 remain active in the application. Applicant acknowledges the acceptance of the drawings submitted in response to the last Office Action. Reconsideration and allowance of the present application is respectfully requested in light of the following remarks.

### **Response to Rejections**

Original claims 1-4, 6, 7, 11, 15-17, 19, 22-27, 29, 32-38, 41, and 42 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wynne (U.S. Pat. App. 2003/0016686 A1). Claims 5, 12, 14, 20, 30, 43, and 44 were similarly rejected under 35 U.S.C. 103(a) as being unpatentable over Wynne in view of Tran (U.S. Pat. App. 2003/0084246 A1). Applicants respectfully traverse these rejections on the grounds that the references are not prior art to the instant application.

Wynne and Tran are published U.S. Patent Applications with a publication date after Applicants' filing date, and a filing date of July 18, 2001, prior to Applicants' November 16, 2001, filing date. Wynne and Tran are therefore presented as prior art under the provisions of 35 U.S.C. § 102(e).

Applicant submitted, along with the response to the September 21, 2005, Office Action, a declaration under the provisions of 37 C.F.R. § 1.131. The Examiner stated that the declaration was ineffective to remove Wynne and Tran as references, and supplied a list of what the Examiner regarded as deficiencies in the declaration. Applicant respectfully disagrees, and addresses below each of the alleged deficiencies in the declaration.

#### *First Objection to Declaration*

The Examiner stated "it is not clear *which part* of Exhibit A Heeloo Chung authored since only part of Exhibit A comes from the design specification."

As a first matter, the Examiner's assertion that "only part of Exhibit A comes from the design specification" is incorrect and conflicts with the inventor's declaration. In paragraph 4 of the declaration, Mr. Chung states "Exhibit A contains several pages excerpted from a Cougar ASIC Internal Design Specification, numbered manually for reference in this declaration." Thus

although only a portion of the Specification is submitted, all of Exhibit A (manually numbered pages 1-9) is taken from the Specification.

Applicant is unaware of a requirement that Heeloo Chung have authored *any* of Exhibit A. The Manual of Patent Examining Procedure states that exhibits may be provided, but does not require that the declarant have authored the exhibits:

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by **any satisfactory evidence of the fact**. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits **may** accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, **in terms of what it is relied upon to show**. MPEP § 715.07.I (emphasis added).

#### *Second Objection to Declaration*

The Examiner stated “it is not clear who the other authors of both the Cougar ASIC Design Specification and Exhibit A are and in particular what contribution was made by Eugene Lee, the other co-inventor.”

Again, the purpose of the declaration is to establish a reduction to practice of the claimed invention based on the Cougar ASIC, not to prove up conception or proper inventorship. Each of several joint inventors is required only to have “made a contribution, individually or jointly, to the subject matter of at least one claim of the application,” not to have authored a design document for an embodiment of an invention. 37 C.F.R. § 1.45(c).

#### *Third Objection to Declaration*

The Examiner stated “with respect to item 4 of applicant’s declaration, it is unclear from Exhibit A what subject matter was placed in the specification prior to July 18, 2001 and in particular whether the claimed subject matter was placed in the specification prior to July 18, 2001.”

Applicant respectfully disagrees. Paragraph 4 of the declaration unequivocally states “the subject matter appearing on the pages excerpted in Exhibit A was placed in the Specification prior to July 18, 2001.” These are the pages of the Specification relied on to establish the reduction to practice. The Manual of Patent Examining Procedure does not require that the Exhibit facially establish its own dates, and in fact allows the dates to be redacted:

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the

actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. M.P.E.P. § 715.07.II.

#### *Fourth Objection to Declaration*

The Examiner stated “none of the figures provided in Exhibit A match those figures provided in the filed specification suggesting that the claimed subject matter was not provided in the specification.”

There is no requirement that the exhibit figures “match” those in the filed application. The Manual of Patent Examining Procedure instructs that the declaration facts show a completion of the invention commensurate with the extent of the invention as claimed:

Further, a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970). M.P.E.P. § 715.02.

Furthermore, the figures in the specification are quite similar to the figures in the application when read in light of paragraph 5 of the declaration, which translates the codenames for the various ASICs in the system. For instance, the figure appearing on page 3 of Exhibit A is quite similar to, and slightly more detailed than, Figure 1 of the application, and some of the details of the page 3 figure also appear in Figures 9 and 10 of the application. The figure appearing on page 1 of Exhibit A shows the major blocks of Figure 2 of the application, and the memory manager subblocks from Figure 2 of the application are further detailed in the figure on page 6 of the specification. The figure appearing on page 2 of Exhibit A is quite similar to Figure 8 of the application.

#### *Fifth Objection to Declaration*

The Examiner stated “applicant failed to provide any proof that the claimed subject matter was placed in the specification prior to July 18, 2001. In particular, Exhibits B and C provide no evidence of what claimed subject matter was placed in the specification prior to July

18, 2001. Instead, Exhibits B and C provide a status update for the Cougar ASIC which may or may not include the claimed invention.”

The Manual of Patent Examining Procedure does not require what the Examiner appears to require:

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. M.P.E.P. § 715.07.II.

Mr. Chung has met this requirement by alleging in paragraph 4 of his declaration that the subject matter of Exhibit A was placed in the specification prior to July 18, 2001.

#### *Sixth Objection to Declaration*

The Examiner stated “with respect to items 5 and 6 of applicant’s declaration and Exhibit A, it is unclear where the claimed subject matter is supported in the Exhibits. In particular, the examiner found no evidence that Exhibit A teaches at least an input for receiving packets of data, *each packet associated with an output queue* or equivalent. Specifically, section 3.2 on page 3 does not teach that each packet is associated with an output queue.

The Manual of Patent Examining Procedure states that the Examiner must consider all of the evidence presented in its entirety, and does not require that a specific exhibit support all claimed limitations:

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and “notes.” An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. M.P.E.P. § 715.07.I.

Specifically regarding the claim element “an input for receiving packets of data, each packet associated with an output queue,” Exhibit A to the declaration does indicate the existence of this element. The page 3 figure shows the Cougar chip having an input FIFO to receive packets, and Section 3.2 describes that “each Cougar can handle up to 12 Gbps of input data traffic.” Section 3.3.1 states that the Tiger to Cougar C-port interface multiplexes data packets. Section 4.4.1.2 states that the Memory Management Unit core block `cg_mq_top` “maintains FIFO head and tail information for up to 256 unicast and 128 multicast queues.” Section 4.4.3.4

states that the head pointer “points to the first chunk in the first packet in the queue,” the tail pointer “points to the last chunk in the last packet in the queue,” and a head length “indicates the size in blocks of the first packet in the queue.” See also the example figure on page 8, showing five input packets associated with different ones of these queues. Section 4.4.3.6 describes how the “requested queue number” is used to add each packet to a queue. In summary, Applicant respectfully submits that one of ordinary skill in the art reading Exhibit A would find ample evidence of the association between packets and output queues in the Cougar ASIC.

### *Seventh Objection to Declaration*

The Examiner stated “the examiner found no evidence that Exhibit A teaches at least an intermediate storage facility manager configured to assign particular blocks of the intermediate storage facility *to output queues, and store one or more packet associated with output queues into blocks assigned to those output queues* or equivalent for the same reasons as mentioned above.

The figure on page 8 of declaration Exhibit A shows five packets associated with three output queues, each packet occupying one or more blocks consisting of 128B of data, a length, and a next pointer (see KEY). Packet p1 occupies three such blocks p1a, p1b, and p1c, all associated with output queue 0 via the head pointer for that queue and the next pointers linking the blocks. Section 4.4.3.6 describes allocating blocks for the packet, modifying pointers for the output queue, and building the chunks of a write packet off-line and linking them, and then appending them to the queue. Applicant respectfully submits that one of ordinary skill in the art reading Exhibit A would find ample evidence of the intermediate storage facility manager.

In conclusion, Applicant respectfully requests that the Examiner reconsider the objections presented to the declaration. Applicants literally built a working embodiment of the claimed device prior to July 18, 2001, as is sufficiently supported, according to guidance from the Manual of Patent Examining Procedure, by the declaration and attached exhibits.

### **Response to Objections**

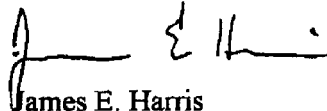
Claims 8-10, 13, 18, 28, 39, and 40 were pending and were objected to as being dependent upon a rejected base claim. For the aforementioned reasons, the base claims from

which claims 8-10, 13, 18, 28, 39, and 40 depend are patentable over the art of record.  
Applicants respectfully request that the instant objections be withdrawn.

**Conclusion**

For the foregoing reasons, Applicants respectfully request allowance of claims 1-44 as presently constituted. The Examiner is encouraged to telephone the undersigned at 512.867.8502 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

  
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Date: 6/8/06

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